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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,959	05/29/2002	David Karroll	49444.1	2377

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CANADA

EXAMINER

CHIN, RANDALL E

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/063,959	KARROLL, DAVID	
	<b>Examiner</b>	<b>Art Unit</b>	
	Randall Chin	1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>09252002</u> . | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Election/Restrictions***

1. Claim 10 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the Paper filed February 17, 2004.

Applicant's election without traverse of Group I, claims 1-9 in the Paper filed February 17, 2004 is acknowledged.

2. In the specification on p. 4, paragraph [0021], it is not exactly clear what part of the nap the term "flattened" is referring to here. The Examiner notes that it is intended that the nap does not extend past the end of the separator 26 as recited.

3. In claim 7, the recitation that the mating surfaces of the discs comprise corresponding "bumps and depressions" appears to be redundant of that already recited back in claim 5, lines 3-4. This appears to be a double inclusion of elements and therefore makes the claims vague.

It appears that claim 9 should depend on claim 8 because of the recitation "the biasing means" in claim 9, line 1.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Torntore '769.

The patent to Torntore '769 discloses in Figs. 1-3 a paint applicator comprising a cylindrical roller sleeve 20 having an exterior textured surface for applying paint to a surface, wherein said roller has a first end and a second end, and the textured surface at the second end is bevelled away (shown in Fig. 1 but not explicitly labeled) from the second end and a "separator" defined by edger device 19b (Fig. 1) attached to and forming part of the second end and having an outside surface, wherein said separator clearly spaces the second end away from a non-painted surface which joins a surface to be painted at an angle.

As for claim 2, the textured surface at the second end is bevelled sufficiently as shown in Fig. 1 such that no part of the textured surface may extend past a plane tangent to the separator outside surface and perpendicular to a roller longitudinal axis. Such a recitation is broad and Torntore '769 would meet this recitation when it is being used for the first time right out of it's package.

As for claim 3, the textured surface at the second end is deemed to be bevelled at "about" a 45 degrees angle (Fig. 1).

As for claim 4, Torntore '769 further teaches a roller holder defined by mandrel 15 affixed to an elongated handle 12, 13a wherein the handle is pivotally adjustable at connector 14 (Fig. 3).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzella '192 in view of Marino '581.

The patent to Mazzella '192 discloses in Figs. 1 and 2 a paint applicator comprising a cylindrical roller sleeve 10 having an exterior textured surface for applying paint to a surface wherein said roller has a first end and a second end and a "separator" defined by collar 13b (Figs. 1 and 2) attached to and forming part of the second end and having an outside surface wherein said separator clearly spaces the second end away from a non-painted surface which joins a surface to be painted at an angle. Mazzella '192 teaches all of the recited subject matter with the exception of the textured surface at the second end bevelled away from the second end. The patent to Marino '581 teaches a paint applicator wherein the second end is bevelled away from the second end as shown in Fig. 1. It would have been obvious to one of ordinary skill in the art to have modified the second end of Mazzella's roller sleeve such that it is

beveled away from the second end as taught by Marino '581 for the purpose of eliminating the need for an edge guard or taping off an adjacent surface that will not be painted.

As for claim 2, the textured surface at the second end of the modified Mazzella device is bevelled sufficiently such that no part of the textured surface may extend past a plane tangent to the separator outside surface and perpendicular to a roller longitudinal axis.

As for claim 3, the textured surface at the second end of the modified Mazzella device is bevelled at "about" a 45 degrees angle.

As for claim 4, Mazzella '192 further teaches a roller holder defined by axle cage structure 12 (Fig. 2) affixed to an elongated handle 14, 16, 34 or 42 wherein the handle is pivotally adjustable.

With respect to claims 5, 6 and 7, Mazzella '192 further teaches that the elongated handle comprises at least two portions (Fig. 4), each portion having a disc 24, 30 comprising a mating surface wherein each mating surface comprises a plurality of projections (or bumps) and depressions 26, 32 (radial serrations) such that the projections of one disc fit within the depressions of the other disc when the two discs are pressed together.

8. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzella '192 in view of Marino '581 as applied to claims 1, 2, 4, 5 and 7 above, and further in view of Ampian '755.

The patent to Ampian '755 teaches a paint applicator that includes a spring member 66 that spring biases two portions 60, 62 together and connected through teeth 38, 64 (or bumps and depressions). The biasing means may be manually overcome to adjust the position of the two portions relative to one another. It would have been obvious to one of ordinary skill in the art to have provided the modified Mazzella device with a biasing means for resiliently biasing the two discs together as suggested by Ampian '755 in order to more easily adjust the position of the discs relative to one another.

As for the spring being a coil spring, it would have been obvious to one skilled in the art to have used such a spring and merely is a functional equivalent of the spring clip taught by Ampian '755 for the purpose of connecting the two portions together.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Kreger, Bedford, Cayo, Lye, Baril, and Bukovitz are pertinent to various paint roller configurations with adjustable handles and beveled edges.

10. Any inquiry concerning this communication or earlier communication from the Examiner should be directed to Randall Chin whose telephone number is (571) 272-1270. The Examiner can normally be reached on Monday through Thursday and every other Friday.

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If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Robert Warden, can be reached at (571) 272-1281. The number for Technology Center 1700 is (571) 272-1700.

The central fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



R. Chin



Randall Chin  
Primary Examiner  
Art Unit 1744